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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,957	08/24/2001	Harald Hoeppner	3238/BDR	2134

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EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/17/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n N .

09/938,957

Applicant(s)

HOEPNER ET AL.

Examin r

Alicia Chevalier

Art Unit

1772

-- Th MAILING DATE f this communication appears n the c ver she t with the c rrespondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-7, in Paper No. 7 is acknowledged.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on February 24, 1999. It is noted, however, that applicant has not filed a certified copy of the Germany application 199 07 940.4 as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites "the plastic coating is printed" which is unclear and renders the claim vague and indefinite. It is unclear from the claim language and the specification whether Applicant is claiming that the plastic coating has printing on it or if Applicant the method of the plastic coating printed on the carrier. In view of claim 1 and the carrier is "printable," for

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purposes of examination it is considered to be the method of the plastic coating printed on the carrier.

***Examiner's Comment***

5. The term "laser-active pigments" in claims 1 and 5 is not found to be indefinite. However, Applicant has not given specific examples or guidelines in the specifications of the types of pigments that constitute "laser-active." Therefore, the term "laser-active" is given its broadest reasonable interpretation from the Merriam-Webster's Collegiate Dictionary 10<sup>th</sup> Ed. A laser is defined as a device that utilizes the natural oscillations of atoms or molecules between energy levels for generating coherent electromagnetic radiation usually in the ultraviolet, visible or infrared regions of the spectrum. Therefore, a "laser-active pigment" is taken to be any pigment that has an action with radiation in the ultraviolet, visible or infrared regions of the spectrum.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hardwick et al. (WO 98/56596).

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Hardwick discloses a multi-layer security product comprising a substrate made of at least one biaxially oriented polymeric film (plastic carrier material) which is coated on both sides with an opacifying pigmentary coating (plastic coating and covering film containing a laser-active pigment) comprising a major proportion of pigment in a minor proportion of a cross-linked polymeric binder. See page 10, lines 1-8. The opacifying pigments block the passage of a specific wavelength, visible light radiation, thus it constitutes a laser-active pigment. The security product further comprises a security feature such as a watermark (page 10 line 25). Furthermore, various indicia maybe formed on at least on the first and second opposing surfaces of the substrate, such as drawings, writing and other designs well known to all users of banknotes (page 9, line 20-22).

The term “printable” in claim 1 is taken to be equivalent to “capable of.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. Since, the biaxially oriented polymeric film of the substrate is able to receive colored layer and various indicia maybe formed on the substrate it is printable.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA

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1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “extruded onto the carrier” in claim 1 and “plastic coating is printed” is a method of production and therefore does not determine the patentability of the product itself.

8. Claims 1, 2, 4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Merkle et al. (5,298,922).

Merkle discloses a security identity card comprising a base layer (printable carrier material), a second color layer provided with pigments that absorbs laser light (plastic coating with laser –active pigments of a specific wavelength), a first color layer (cover film) substantially permeable to laser light (col. 6, lines 14-19 and figure 2). The color layers may be dyed plastic films (col. 2, lines 22-36). The card may further comprise a printed security pattern such as a guilloche (security features) pattern (col. 2, lines 22-36). From figure 6 it can be seen that the second color layer has embossing.

The term “printable” in claim 1 is taken to be equivalent to “capable of.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. Since, the data carrier color layer may be screen printed on the base (col. 2, lines 22-24) it is printable.

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The term “such as” is taken to be optional language. In the instant case in claim 4 the limitation “such as watermarks and/or mottled fibers on the carrier material is taken to optional examples of the security features. Furthermore, the limitations of this claim are meet with any additional security feature.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “extruded onto the carrier” in claim 1 and “plastic coating is printed” is a method of production and therefore does not determine the patentability of the product itself.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Riedl (5,928,788), Blome (5,774,168) and Maurer et al. (4,597,592) all disclose similar multi-layer security products.

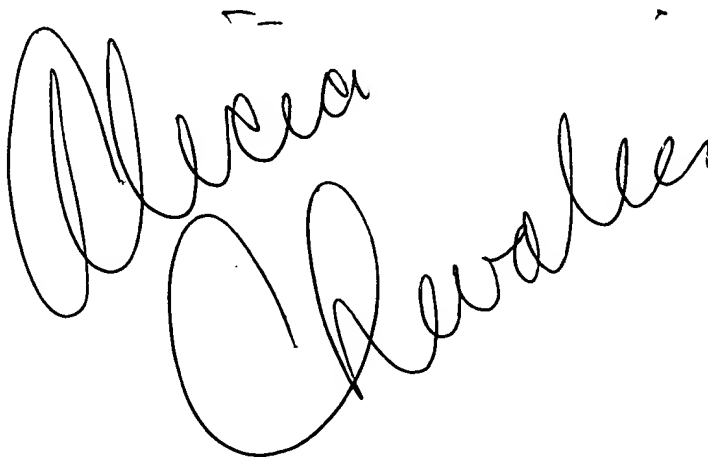
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

7/12/03

A handwritten signature in cursive script, reading "Alicia Chevalier". The signature is written in black ink and is positioned below the typed name.